

REMARKS

In the Non Final Office Action¹ mailed October 5, 2006, the Examiner rejected claims 1-12, 14-30, 32-48 and 50-54 under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,401,085 to Gershman et al. ("*Gershman*") in view of U.S. Patent No. 6,061,660 to Eggleston ("*Eggleston*"). For the reasons stated below, Applicants respectfully traverse the rejections of claims 1-12, 14-30, 32-48, and 50-54 under 35 U.S.C. § 103(a).

I. Rejection of claims 1-12, 14-30, 32-48 and 50-54 under 35 U.S.C. § 103(a) as being unpatentable over *Gershman* in view of *Eggleston*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-12, 14-30, 32-48 and 50-54 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Gershman* nor *Eggleston*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

For example, claim 1 recites a method for providing solicitations and web-based offers and receiving corresponding responses thereto, including, among other things:

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

providing a solicitation to a set of users sharing pre-selected characteristics, incorporating in the solicitation at least an offer code and a universal resource locator (URL) corresponding to a web site. (emphasis added)

In rejecting claim 1, the Examiner admits that *Gershman* fails to teach: “solicitations, url, and offer code” (Office action at p. 3). The Examiner, however, cites *Eggleston* as allegedly disclosing these elements. According to the Examiner, *Eggleston* “discloses solicitations, url, and offer code in relation to incentive programs and award fulfillment.” This is not correct.

For example, the Examiner asserts² that *Eggleston*, at col. 13, line 43 to col. 14, line 5, recites “solicitations” by disclosing “incentive programs such as including advertising or product logos as part of the graphical object viewed by the consumer when playing an incentive program.” Even assuming the Examiner’s assertion is correct, which Applicants do not concede, the “incentive programs” of *Eggleston* do not constitute “solicitations,” as recited in claim 1.

Eggleston instead recites a “typical user” logging on to a website and participating in “one or more incentive programs.” The “incentive programs” disclosed by *Eggleston* include “scratch-and-win games, sweepstakes, games, treasure hunt games or computer games” (col. 13, lines 43-47). Therefore, while *Eggleston* may include “incentive programs” accessible by a consumer by logging on to a website, this does not constitute “providing solicitations,” as recited in claim 1 because the claimed “solicitation” incorporates “an offer code.”

The Examiner alleges that *Eggleston*, at col. 1, line 63 to col. 2, line 8, “teaches offer code when he discloses offer promotions” (Office action at p. 3). This is not correct.

² Office Action mailed October 5, 2006 at p. 3.

Eggleston merely discloses that a “problem exists for sponsoring companies who wish to offer promotions” (col. 1, lines 63-64). Therefore, “offer,” as employed by *Eggleston* in the cited passages, refers to a verb, rather than a noun. Nothing in *Eggleston* discloses or suggests a “solicitation” incorporating “an offer code,” as recited in claim 1.

Applicants respectfully submit that neither the portions of *Gershman* or *Eggleston* cited by the Examiner, nor any other portion, disclose or suggest each and every element of claim 1. Absent a teaching or suggestion of at least a “solicitation”, an “offer code,” and a “URL,” related in the manner specified by claim 1, the cited prior art cannot render obvious the method recited in claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

Claims 12, 16, 19, 30, 34, 37, 48 and 52 include recitations similar to those of claim 1. Accordingly, the cited art also cannot render obvious independent claims 12, 16, 19, 30, 34, 37, 48 and 52 for at least the same reasons set forth above in connection with claim 1. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

Claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, and 54 depend from the independent claims cited above (i.e., 1, 12, 16, 19, 30, 34, 37, 48, and 52). As explained, neither *Gershman* nor *Eggleston* support the rejection of claims 1, 12, 16, 19, 30, 34, 37, 48, and 52. Accordingly, the cited art also fails to support the rejection of dependent claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, and 54 under 35 U.S.C. § 103(a) for at least the same reasons set forth above in connection with claim 1. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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